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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,146

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EXAMINER

CHOKSHI, PINKAL R

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/540,146	Applicant(s) MAETZ ET AL.	
	Examiner PINKAL CHOKSHI	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 28 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101. Claim 28 is claiming a program and program itself cannot be patented.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 15, 16, and 20-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,020,883 to Herz et al (hereafter referenced as Herz) in view of US Publication US 2002/0133817 A1 to Markel et al (hereafter referenced as Markel).

Regarding **claim 15**, "acquisition device for obtaining files by accumulating points, designed for at least one user of at least one receiver of data of at least one communication network" reads on a system for scheduling the receipt of

desired movies and program data from a network (abstract) discloses by Herz and represented in Figs. 4 and 5. Herz further discloses (col.4, lines 20-25) that the receiver receives desired programming data based on user preference from broadcasting server. As to “to acquire at least one of said files by downloading of said file via said communication network when the aggregate number of said points reaches a predetermined level associated with said file” Herz discloses (col.3, lines 1-12; col.4, lines 20-31) that the receiver receives the audio/video programming data/file from server based on the user preference. Herz further discloses (col.10, lines 5-10; col.23, line 65-col.24, line 10; col.28, lines 20-26; col.48, lines 12-16) that the agreement matrix, which matches available video programs with user preference, is created and when the threshold for this matrix reaches above/below limit, based on the response from receiver, server sends desired programming data to receiver as represented in Figs. 1 and 2.

As to “wherein said device comprises an automatic control module for ordering downloading via said network to a storage space accessible to said receiver” Herz discloses (col.45, lines 52-60) that the program list indicating those video programs based on the user preference is stored in memory of the set-top box as represented in Fig. 9 (element 902). As to “of portions of said file, designed to order the downloading of each of said portions when the number of points earned by said user reaches a fraction of said predetermined level which corresponds to said portion” Herz discloses (col.27, lines 39-42; col.46, lines 10-30) that the user receives all the video programs list from the server based on the

user preference provided to the user. Based on user's viewing history, server sends n programs to the user. When popularity or the threshold for a program falls below the limit, then the server sends new list of n programs based on the user's viewing history and their preferences.

Applicant's process of receiving programs/advertisements and based on these programs/ads, user receives desired programs is similar to Herz's process where head-end transmit programming data to receiver and based on the viewer's history/preference sent to server, head-end transmits desired programming data to receiver. Herz meets all the limitations of the claim except "user being able to earn points by occurrences of at least one predefined operation accomplished by said user." However, Markel discloses (¶0011 and ¶0014) that the viewers earn points by watching program contents or advertisements that they pre-registered. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to substitute threshold counter of the head-end/receiver system taught by Herz et al with the points earned for watching programs/advertisements of Markel et al would have yielded predictable result of receiving desired program to a person of ordinary skills in the art at the time of the invention.

Regarding **claim 16**, "acquisition device for obtaining files wherein it comprises a module for prior selection of at least one content by said user, said downloaded file carrying said content" Herz discloses (col.4, lines 20-30) that

server transmits programming data to receiver based on the user's preference to watch desired programs.

Regarding **claim 20**, Herz meets all the limitations of claim except "acquisition device for obtaining files wherein it comprises a module for recording the aggregate number of points in respect of the acquisition of each of said files and a module for communicating said aggregate number to said user." However, Markel discloses (§0016) that the software accumulates the point values with previous points and stores the result in the memory. Markel further discloses (§0015) that the viewers can review their account status for information. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to store points and allow user to see accumulated points as taught by Markel so the use can have up to date count on points they accumulated.

Regarding **claim 21**, "acquisition device for obtaining files wherein the ratio of sizes of each of said portions of file with respect to said file is equal to the ratio of the number of points of said fraction associated with said portion with respect to said predetermined level for said file" Herz discloses (col.25, lines 17-29) that based on agreement matrix created from user profile, programs with the highest value and the closest match to user's profile are prioritized and transmitted to the receiver.

Regarding **claim 22**, "acquisition device for obtaining files wherein the automatic control module is designed to order said downloading on each of said occurrences" Herz discloses (col.46, lines 10-12; col.47, lines 25-29) that the processor determines a list of channels to provide to viewers from the user profile.

Regarding **claim 23**, "acquisition device for obtaining files wherein the automatic control module is designed to order the downloading of files of at least one of the following types: MPEG video files and MP3 audio files" Herz discloses (col.4, lines 20-34; col.54, lines 37-40) that the video/audio programming data are provided to the display device of receiver.

Regarding **claim 24**, "acquisition device for obtaining files wherein it comprises a module for detecting said occurrences" Herz discloses (col.6, lines 37-41) that the system updates user profile accordance with the video programming watched by the customer.

Regarding **claim 25**, "acquisition device for obtaining files wherein said operations are chosen from at least one of the following operations: viewing of advertisements, listening to advertisements, consulting of Internet sites and responses to questionnaires by telecommunication" Herz discloses (col.48, lines

37-40) that the user profile or agreement matrix is used to select advertisements that the customer is most likely to watch.

Regarding **claim 26**, “acquisition process for obtaining files by accumulating points” reads on a system for scheduling the receipt of desired movies and program data from a network (abstract) discloses by Herz and represented in Figs. 4 and 5. Herz further discloses (col.4, lines 20-25) that the receiver receives desired programming data based on user preference from broadcasting server. As to “acquires at least one of said files by downloading of said file via said communication network when the aggregate number of said points reaches a predetermined level associated with said file” Herz discloses (col.3, lines 1-12; col.4, lines 20-31) that the receiver receives the audio/video programming data/file from server based on the user preference. Herz further discloses (col.10, lines 5-10; col.23, line 65-col.24, line 10; col.28, lines 20-26; col.48, lines 12-16) that the agreement matrix, which matches available video programs with user preference, is created and when the threshold for this matrix reaches above/below limit, based on the response from receiver, server sends desired programming data to receiver as represented in Figs. 1 and 2.

As to “wherein a downloading via said network to a storage space accessible to said receiver” Herz discloses (col.45, lines 52-60) that the program list indicating those video programs based on the user preference is stored in memory of the set-top box as represented in Fig. 9 (element 902). As to “of

portions of said file is ordered automatically by ordering the downloading of each of said portions when the number of points earned by said user reaches a fraction of said predetermined level which corresponds to said portion” Herz discloses (col.27, lines 39-42; col.46, lines 10-30) that the user receives all the video programs list from the server based on the user preference provided to the user. Based on user's viewing history, server sends n programs to the user. When popularity or the threshold for a program falls below the limit, then the server sends new list of n programs based on the user's viewing history and their preferences.

Applicant's process of receiving programs/advertisements and based on these programs/ads, user receives desired programs is similar to Herz's process where head-end transmit programming data to receiver and based on the viewer's history/preference sent to server, head-end transmits desired programming data to receiver. Herz meets all the limitations of the claim except “in which a user of a receiver of data of a communication network earns points by accomplishing at least one predefined operation.” However, Markel discloses (¶0011 and ¶0014) that the viewers earn points by watching program contents or advertisements that they pre-registered. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to substitute threshold counter of the head-end/receiver system taught by Herz et al with the points earned for watching programs/advertisements of Markel et al would have

yielded predictable result of receiving desired program to a person of ordinary skills in the art at the time of the invention.

Regarding **claim 27**, "interactive terminal wherein it comprises an acquisition device for obtaining files" Herz discloses (col.46, line 67-col.47, line 2) that the video programming content are received from head-end by tuner as represented in Fig. 10 (element 1002).

Regarding **claim 28**, the office assumes program recorded on a storage medium of a computer. As to "computer program product comprising program code instructions for the execution of the steps of the process according to claim 26 when said program is executed on a computer" Herz discloses (col.50, lines 6-7) that the method of the invention can be implemented in a personal computer as represented in Fig. 11.

4. **Claims 17-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,020,883 to Herz et al in view of US Publication US 2002/0133817 A1 to Markel et al as applied to claim 15 above, and further in view of US Publication 2003/0167205 A1 to Maruyama et al (hereafter referenced as Maruyama).

Regarding **claim 17**, "acquisition device for obtaining files wherein the module for prior selection allows said user to select at least two contents" Herz

discloses (col.4, lines 25-27) that one or more channels data are determined based on the user profile's agreement matrix.

Combination of Herz and Markel meets all the limitations of the claim except "said device comprises a module for apportioning said points earned into at least two accounts associated respectively with contents." However, Maruyama discloses (§0077) that the user applies his/her accumulated points to purchase an item A and uses the remaining point to purchase a second item B as represented in Fig. 16. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to share points to purchase multiple items as taught by Maruyama in order to provide various premiums by accumulation of these points to thereby realize repetitive utilization (§0003).

Regarding **claim 18**, "acquisition device for obtaining files wherein it comprises a module for allocating priority designed to permit said user to choose an order of priority of assignment of the points earned to said accounts" Herz discloses (col.25, lines 17-29) that the agreement matrix prioritized programs based on the closest match to the user profile.

Regarding **claim 19**, "acquisition device for obtaining files wherein the apportioning module is designed to assign the points earned to the account benefiting from the highest priority, and when the aggregate number of points in respect of the account benefiting from the highest priority reaches said

predetermined level, to assign the additional points earned to the accounts having lower priorities, according to said order of priority” Herz discloses (col.25, lines 17-29; col.30, lines 41-46) that based on the importance given to a certain movie or a program by customer, server updates agreement matrix and transmits prioritized programs to the receiver.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Publication 2003/0172376 A1 to Coffin, III et al discloses user controlled targeted advertisements placement for receiver modules.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PINKAL CHOKSHI whose telephone number is (571) 270-3317. The examiner can normally be reached on Monday-Friday 8 - 5 pm (Alt. Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Pendleton can be reached on 571-272-7527. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/PRC/

/Brian T. Pendleton/

Supervisory Patent Examiner, Art Unit 2623